

PATENT  
Atty Dkt 2000-0526.21  
Client LA93-076-02

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on 17 August 1995.

Sharon Kaul  
Signature

Sharon Kauls  
Typed or printed name

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Christopher J. EVANS et al.

Serial No.: 08/403,260

Group Art Unit: Unknown

Filed: 13 March 1995

Examiner: Unknown

For: OPIOID RECEPTOR GENES

CONSENT OF ASSIGNEE

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

The Regents of the University of California, the Assignee of the entire right, title and interest in the above-referenced application, hereby consents to the change of inventorship in this application to add the names of Robert H. Edwards and Daniel Kaufman. The undersigned is authorized to execute this consent on behalf of the Regents.

May 27, 1995  
Date

Claire T. Wake  
Claire T. Wake, Director  
Office of Intellectual Property



Attorney Docket No. 2000-0526.21

**COMBINED DECLARATION AND POWER OF ATTORNEY  
FOR CONTINUATION-IN-PART APPLICATION**

**AS A BELOW-NAMED INVENTOR, I HEREBY DECLARE THAT:**

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if more than one name is listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled: OPIOID RECEPTOR GENES, the specification of which

(check one)  is attached hereto  
 was filed on 13 March 1995

as application serial no. 08/403,260.

**I HAVE REVIEWED AND UNDERSTAND THE CONTENTS OF THE ABOVE-IDENTIFIED SPECIFICATION, INCLUDING THE CLAIMS, AS AMENDED BY ANY AMENDMENT REFERRED TO ABOVE.**

I acknowledge and understand that I am an individual who has a duty to disclose information which is material to the patentability of the claims of this application in accordance with Title 37, Code of Federal Regulations, §§ 1.56(a) and (b) which state:

"(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or

attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
  - (i) Opposing an argument of unpatentability relied on by the Office, or
  - (ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability."

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below, and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) and (b) set forth above which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

Application Serial No.: 08/403,260

Filing Date: 13 March 1995

Status (patented, pending, abandoned): Pending

Application Serial No.: 08/387,707

Filing Date: 13 February 1995

Status (patented, pending, abandoned): Pending

Application Serial No.: 07/929,200

Filing Date: 13 August 1992

Status (patented, pending, abandoned): Pending

As to the subject matter of this application which is common to said earlier application, I do not know and do not believe that the same was ever known or used in the United States of America before my or our invention thereof or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to said earlier application, or in public use or on sale in the United States of America more than one year prior to said earlier application. Said common subject matter has not been patented or made the subject of an inventor's certificate issued before the date of said earlier application in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months prior to said earlier application; and the earliest application(s) for patent or inventor's certificate on said invention filed by me or my legal representatives or assigns in any country foreign to the United States of America is identified below, as well as all other such applications (if any) filed more than twelve months prior to the filing date of this application:

The priority of the earliest application(s) (if any) filed within a year prior to said pending prior application is hereby claimed under 35 U.S.C. § 119.

As to the subject matter of this application which is not common to said earlier application, I do not know and do not believe that the same was ever known or used in the United States of America before my or our invention thereof or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to the date of this application, or in public use or on sale in the United States of America more than one year prior to the date of this application. Said subject matter has not been patented or made the subject of an inventor's certificate issued in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months prior to the date of this application; and the earliest application(s) for patent or inventor's certificate on said subject matter filed by me or my legal representatives or assigns in any country foreign to the United States of America is identified below, as well as all other such applications (if any) filed more than twelve months prior to the filing date of this application:

The priority of the earliest application(s) (if any) filed within a year to this application is hereby claimed under 35 U.S.C. § 119.

I hereby appoint the following attorneys and agents to prosecute that application and to transact all business in the Patent and Trademark Office connected therewith and to file, to prosecute and to transact all business in connection with all patent applications directed to the invention:

Reid G. Adler - Reg. No. 30,988  
David L. Bradfute, Reg. No. P-39,117  
Thomas E. Ciotti - Reg. No. 21,013  
Patricia M. Drost - Reg. No. 29,790

Edward G. Durney - Reg. No. 37,611  
Tyler Dylan - Reg. No. 37,612  
Nancy Joyce Gracey - Reg. No. 28,216  
Gary A. Green - Reg. No. 38,474

Stuart P. Kaler - Reg. No. 35,913  
Paul C. Kimball - Reg. No. 34,641  
Antoinette F. Konski - Reg. No. 34,202  
Susan K. Lehnhardt - Reg. No. 33,943  
Shmuel Livnat - Reg. No. 33,949  
Harry J. Macey - Reg. No. 32,818  
Gladys H. Monroy - Reg. No. 32,430  
Kate H. Murashige - Reg. No. 29,959  
Jackie N. Nakamura - Reg. No. 35,966  
Freddie K. Park - Reg. No. 35,636  
Paul F. Schenck - Reg. No. 27,253  
James R. Shay - Reg. No. 32,062  
Debra A. Shetka - Reg. No. 33,309  
Cecily Anne Snyder - Reg. No. 37,448  
E. Thomas Wheelock - Reg. No. 28,825

and:

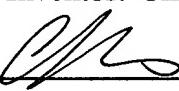
Address all correspondence to: Kate H. Murashige

MORRISON & FOERSTER  
2000 Pennsylvania Avenue, N.W.  
Suite 5500  
Washington, D.C. 20006-1888

Address all telephone calls to: Kate H. Murashige at 202-887-1533.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name Inventor: Christopher J. Evans

Signature: 

Date 5/12/95

Residence: Venice, California

Citizenship: United Kingdom

Post Office Address: 1635 Shell Avenue, Venice, California

Full Name Inventor: Duane E. Keith, Jr.

Signature: Duane E. Keith

Date 5/17/95

Residence: Woodland Hills, California

Citizenship: United States

Post Office Address: 23805 Tiara Street, Woodland Hills, California

Full Name Inventor: Robert H. Edwards

Signature: R. Edwards

Date 5/22/95

Residence: Los Angeles, California

Citizenship: United States

Post Office Address: 120 Granville, #19E, Los Angeles, California

Full Name Inventor: Daniel Kaufman

Signature: Daniel Kaufman

Date 5-14-95

Residence: Santa Monica, California

Citizenship: United States

Post Office Address: 1453 Centinela Avenue, Apt. C, Santa Monica, California



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Atty Dkt 2000-0526.21  
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Sharon Haws  
Signature

SHARON HAWS  
Typed or printed name

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Christopher J. EVANS et al.

Serial No.: 08/403,260

Group Art Unit: Unknown

Filed: 13 March 1995

Examiner: Unknown

For: OPIOID RECEPTOR GENES

VERIFIED STATEMENT OF FACTS

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

We, Christopher J. Evans and Duane E. Keith, the original named inventors herein, verify that to the best of our knowledge, the following facts establish when the error in inventorship without deceptive intention was discovered and how it occurred.

1. The above-referenced application was filed on the basis of instructions set forth in a letter from the Director of the Office of Intellectual Property of the assignee herein which provided additional subject matter for the above-referenced application related to the ORL-1 clone. The letter stated that the inventors "appear to be Chris Evans and Duane Keith." It was necessary to file the application within several days of the receipt of the letter in order to precede an intended publication date.

2. In placing the application on file, the two names as set forth in the letter were inadvertently listed as the only inventors, although the subject matter claimed included substantial (indeed, most) material already disclosed and claimed in the parent application of which this application is a continuation-in-part. Upon review of the filed application, this became apparent both to the attorney of record and to the Office of Intellectual Property; it was evident that the inventorship entity set forth on the parent application was appropriate here. Accordingly, the present petition is diligently made to correct this inadvertent error.

3. Thus, the error in inventorship was without deceptive intention. It was discovered when the application was reviewed subsequent to filing in preparation for providing the requisite papers in response to an anticipated Notice of Missing Parts. The error without deceptive intention occurred in filing the present application containing new matter which was stated to be ascribable only to two of the original named inventors and overlooking the inclusion of subject matter previously disclosed and claimed.

We verify that to the best of our knowledge and belief, the foregoing facts are correct.

5/17/95  
Date

  
Christopher J. Evans

5/17/95  
Date

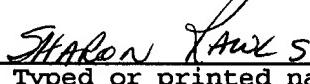
  
Duane E. Keith

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\_\_\_\_\_  
Signature

  
\_\_\_\_\_  
Typed or printed name

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We verify that to the best of our knowledge and belief, the foregoing facts are correct.

5/17/95  
Date

C.J.E.  
Christopher J. Evans

5/17/95  
Date

D.E.K.  
Duane E. Keith